

REMARKS

By this Amendment, claims 1-7 are amended to improve clarity. Specifically, claims 1-7 are amended to recite that the V93 mutation is found in the sequence of SEQ ID NO:89 or a corresponding residue of one of SEQ ID NOs 83-88 and 90-108. Support for the amendment to the claims comes from the specification, as originally filed, at page 12, lines 10-16, and Figure 7, for example. Accordingly, no new matter is added. Currently, claims 1-26 are pending, claims 11 and 22-26 having been withdrawn by the Office as directed to non-elected inventions.

I. Restriction Requirement

The Office maintains the withdrawal of claims 11 and 22-26 as directed to non-elected Groups. (Office Action at page 2.) Applicants request that the Office consider rejoinder of the non-elected claims upon a determination of allowability of the elected claims.

II. Objection To The Claims

The Office objects to claims 1-10 and 12-21 as including non-elected subject matter. (Office Action at page 3.) Applicants request that the Office hold this objection in abeyance until the Office has performed an adequate search of the scope of the claims to conclude that the full scope of the claims is patentable.

III. *Rejection Under 35 U.S.C. § 112, second paragraph*

The Office rejects claims 1-10 and 12-21 under 35 U.S.C. § 112, second paragraph, as indefinite for reciting “an amino acid mutation at V93”, whereas the sequence of SEQ ID NO:108 does not include a valine residue at position 93. (Office Action at page 4.) By this Amendment, independent claims 1-7 are amended to clarify that the mutation recited in the claims is at residue V93 of SEQ ID NO:89 or a corresponding residue of one of the other sequences recited in the claims. Applicants thank the Examiner for identifying this lack of clarity, and submit that the claims, as currently presented, are clear, definite, and recite the subject matter intended by Applicants. Applicants submit that the amendment to the claims corrects prior unclear wording of the claims, but does not alter the scope or content of the claims.

In view of the amendments to claims 1-7, Applicants request that the Office reconsider and withdraw the rejection of claims 1-10 and 12-21 as indefinite under 35 U.S.C. § 112, second paragraph.

IV. *Rejection Under 35 U.S.C. § 112, first paragraph*

The Office rejects claims 1-10 and 12-26¹ as containing subject matter that was not described in the specification in a manner that would convey to a skilled artisan that Applicants had, at the time the application was filed, possession of the claimed invention. (Office Action at page 5.) In setting forth the rejection, the Office asserts that the specification does not disclose

¹ Claims 22-26 stand withdrawn. Applicants will respond to this rejection as it applies to claims 1-10 and 12-21, under the assumption that the Office Action contains a simple typographical error.

an enzyme having the sequence of SEQ ID NO:108, which includes a valine residue at position 93. Applicants traverse this rejection as it applies to the present claims.

By this Amendment, independent claims 1-7 are amended to recite that the V93 mutation is within SEQ ID NO:89 residue V93 of SEQ ID NO:89 or a corresponding residue of one of the other sequences recited in the claims. The amendment thus addresses the Office's concern as to the absence of a V93 residue in SEQ ID NO:108. Applicants submit that all of their prior arguments with regard to enablement and the adequacy of the written description for the claimed mutants, within the context of currently examined SEQ ID NO:108, are applicable to SEQ ID NO:108, and that the Board's decision should be controlling to the extent that the Office further considers patentability of the claims under 35 U.S.C. § 112, first paragraph.

In view of the amendments to the claims made herein, Applicants request that the Office reconsider and withdraw the rejection of claims 1-10 and 12-21 as lacking full written description support under 35 U.S.C. § 112, first paragraph.

V. *Conclusion*

Applicants submit that all of the issues raised by the Office in the Office Action dated 29 October 2010 have been addressed and overcome. Therefore, Applicants request that the Office reconsider and withdraw the rejections set forth in that Office Action, rejoin the non-elected claims, and allow the full scope of the application and claims. If the Office believes anything further is necessary to place this application in condition for allowance, Applicants request that their undersigned representative be contacted at the telephone number listed below.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this paper, such extension is hereby respectfully requested. If there are any fees due that are due to obtain entry of this paper, please charge such fees to Deposit Account No. 19-0089.

Respectfully submitted,
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